

REMARKS/ARGUMENTS

Claims 2-16, 18-30 and 32-48 are pending in this application. Applicants have thoroughly reviewed the Office Action and the references cited therein. The following remarks are believed to be fully responsive to the Office Action. All the claims are believed to be patentable over the cited references.

CLAIM REJECTIONS UNDER 35USC§103(a)

According to MPEP 706.02(j), the following establishes a *prima facie* case of obviousness under 35 U.S.C. §103:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In *re* Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

A. Claims 2-16, 18-30, and 32-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kail (USPN 5,959,529). in view of Chiliwnyj et al. (USPN 6,574,679).

The Applicant respectfully traverses.

In paper number 20070820, the Examiner states that the claims have been given the broadest reasonable interpretation and that is why the rejection must stay. However, still all the limitations of the invention must still be taught or suggested in a 35USC103 rejection. Specifically, the Examiner points to the arguments of the configuration of the monitoring unit and the equipment being monitored. However, the claim specifically shows the separation of the

items, as the hardware controller with the unique identifier is attached to the equipment being monitored, but the apparatus that monitors the equipment is claimed as being detached from the equipment as shown below.

The Examiner in paper no. 20070820 refers to col. 2-3, lines 59-57 and 1-5, of Kail. Looking closely at the text, it is the unique identifier of the sensor. The configuration information is of the sensor to monitor the subject. However, the unique identifier does relate to the subject being monitored. This is different and important because to have the configuration information of the sensor, is helpful when keeping track of the sensor and its configuration, but it does not help in terms of keeping track of the actual configuration of the subject and it is not the point of Kail. Kail in col. 1, lines 6-65 mentions to check the status of living or inanimate subject. The sensor of Kail can relay the information of the location of a bird in flight or a painting in storage, but the actual configuration of the subject is not important. There lies a difference, as the configuration being claimed is different and thus being used for different purposes. The configuration of a bird is not important to Kail, because it does not have a configuration. The configuration of a painting is not important because it does not have one or may not have one. A separate comparison would have to be made in order to link the sensor with the painting, but even then, the actual configuration such as the type of canvas, etc. may not be identified unless it is separately inputted by time consuming inspection of the painting.

Kail is not only different in terms of the configuration being dealt with, it is actually teaching away from the present invention as it holds the indicia of the sensor and not the subject being monitored. There is a big difference and the effect is different also as shown above. It is not a matter of broad interpretation, but merely looking at the claimed limitations that must all be taught or suggested. The claims clearly show that the configuration information involved is relating to the subject being monitored and not the attached controller or sensor.

For example, if one were to apply the teaching of Kail to a refrigerator, one can get the information of the sensor identifier and the sensed information of the sensor, but there would be

no information of the actual configuration of the refrigerator. For example, if operating limits are a concern for different refrigerators, Kail and the combination with Chiliwnyj, cannot teach retrieving such information of the equipment being monitored, but rather of the sensor and sensed information. The sensor cannot sense the operating limits of different equipment. In Kail, one would then have to input the information from a separate book or manual, after it is searched or hand entered at a certain time, thus being time consuming a potentially inaccurate.

Specifically with regards to claim 2, the Examiner stated that Kail (USPN 5,959,529) teaches a device that provides diagnostic and control capability for equipment from a remote location comprising: an apparatus detached from the equipment comprising a display device, (34,54; See figure 1) an input device, (28;figure 1) software (82;figure 3) executed by the apparatus and a communications device; (16, 58;See figure 1) and a hardware controller (22;figure 1) attached to the equipment to enable monitoring of the equipment by the apparatus through the communications device, wherein a unique identifier is stored on the controller, (Col.6, lines 20-21) the unique identifier is assembled using an array of data (Col. 3, lines 10-14).

However, the present invention claims that the unique identifier is compiled using a number of pieces of data accommodating decoding specific manufacturing configurations of the equipment. On the other hand, Kail only teaches a plurality of portable monitoring units, to uniquely identify each unit and the data relative to its configuration and use.

The Examiner in paper no. 20070820 states of the broad interpretation of the claims and with regard to the compilation of data in order to be decoded in 60, figure 1.

The , the computer of 60 does not teach or suggest the specifics of compiling the data for decoding. The compiling is not specifically taught or suggested and cannot be assumed by the presence of a computer. Compiling has a specific "plain" meaning and that limitation is not addressed by Kail or Chiliwnyj.

First, Kail is referring to the configuration of the portable monitoring units as it is saying “uniquely identify each unit” and it refers to the “portable monitoring units.” The present invention is referring to the controller on the equipment. Meanwhile Kail is referring to the identity of the monitoring unit itself. Respectfully the configuration of the monitoring units is quite different from the configuration of the equipment being monitored.

As seen in FIG. 1 of Kail, reference 10 and 12 refer to the portable monitoring apparatus only.

Secondly, the unique identifier of the present invention is compiled using parts of data that can be decoded for specific manufacturing configurations of the equipment. Kail fails to disclose the compiling or decoding the unique identifier for the specific configurations of the equipment. The compiling or decoding of such data is not taught or suggested. Further, the parts of the data or the pieces of the data do not allow compiling of the unique identifier to where it can be decoded for specific manufacturing configurations of the equipment.

The Examiner in paper no. 20070820 states of the broad interpretation of the claims and with regard to decoding the unique identifier for the specific configurations of the equipment as seen in col. 2, lines 60-63 of Kail.

Again, as shown above, Kail teaches the unique identifier of the sensor and not the equipment being monitored. Kail specifically states the unique unit identifier, where the unit refers to the sensor interface unit.

With regards to claim 3, the Examiner states that Kail (USPN 5,959,529) teaches the controller is queried by the apparatus. (Col. 8, lines 58-63). However, the amended claim also states that the unique identifier accommodates diagnosing and servicing of the equipment, which neither Kail or the other references teach or suggest.

With regards to claim 4, the Examiner states that Kail (USPN 5,959,529) teaches the controller transmitting data to the apparatus without being queried. (Col. 8, lines 58-67).

However, the amended claim also includes the controller embedded in the equipment, which as seen in FIG. 1, the monitoring apparatus fails to be embedded in the equipment itself.

With regards to claim 11, the Examiner states that Kail (USPN 5,959,529) teaches the software code is programmed with acceptable operational limits for the equipment associated with the identifier. (Col. 2, lines 63-67).

However, the claim also states as amended, evaluating certain bits of data and comparing the identifier to acceptable operating limits for the equipment. Kail or the other reference fails to teach the evaluation of the identifier being in certain operating limits.

These remarks also apply to the method claim 21.

With regards to claim 15, Kail (USPN 5,959,529) teaches the predetermined task is transmitting data to the equipment to adjust certain operational features of the equipment. (364;figure 6). However, as amended, the device of Kail fails to have a set point view as claimed and certain feature sets. Kails does not have such limitations.

With regards to claim 18, the Examiner states that Kali (USPN 5,959,529) teaches a method that provides remote diagnostic and control capability for equipment comprising: monitoring the equipment through a hardware controller attached the equipment (Col. 4,lines 19-23) with a remote apparatus comprised of an input device, (28;figure 1) display device, (34,54; See figure 1) a communications device(16, 58;See figure 1) and software code executed by the apparatus. (82;figure 3, Col. 7, lines 64-65) storing a unique identifier on the controller that is attached to the equipment, (Col.6, lines 20-21) the unique identifier is assembled using an array of data (Col. 3, lines 10-14).

However, the remarks of claim 1 pertain to the method claim 18.

With regards to claim 19, Kail (USPN 5,959,529) and the other references fail to teach setting the local network address through a comparison and a field in the unique identifier itself.

The network address is not obtained in such a manner in Kail or the other references.

With regards to claim 20, Kail (USPN 5,959,529) and the other references fail to teach or suggest a communication recovery mode:

With regards to claim 32, the remarks for claim 2 pertains.

With regards to claim 34, Kail (USPN 5,959,529) and the other references fail to teach or suggest the set point view as claimed.

B. Claims 44-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kail (USPN 5,959,529) in view of Hayward (US publication 2003/0023703). The Applicant respectfully traverses.

The Examiner states that Hayward teaches of the specific identifiers in paragraph 25. However, respectfully, Hayward is not storing the identifiers on the separate controller that is attached to the equipment being monitored. Rather, the information is within the equipment itself. This configuration is problematic, for example, then all equipment such as refrigerator must then have an entire computer, which is not practical.

In fact Hayward is teaching away from the present invention in that, as mentioned in paragraph 25, the peripheral indicia is at computer 30, and not on a controller that is attached to the separate equipment. The user is then reliant on the equipment itself to contain all the information needed and also control of the information is lost. Therefore, Hayward should not be combined with Kail.

According to MPEP §2145, "It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). This portion of Hayward cannot be just ignored because according to MPEP §2141.02, "A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984)." Therefore, since one cannot merely pick and chose from different references, the

manner of the storage of information in Hayward is teaching away from the present invention and therefore, Hayward should not be combined with Kail.

Additionally, according to MPEP §2141.01(a) and cases such as *In re Oetiker*, the reference of Hayward and therefore the combination is not within the field of applicant's endeavor, and is not reasonably pertinent to the particular problem with which the inventor was concerned because it has to be shown that person of ordinary skill, seeking to solve a problems of a variety of equipment would reasonably be expected or motivated to look to include an entire computer in each equipment or that it is limited to only computers.

CONCLUSION

In view of the foregoing remarks, Applicants respectfully request that the outstanding rejections be removed. If, for any reason, the Examiner disagrees, please call the undersigned attorney at 202-861-1737 in an effort to resolve any matter still outstanding before issuing another action. The undersigned attorney is confident that any issue which might remain can readily be worked out be telephone.

In the event this paper is not time filed, Applicants petition for an appropriate extension of time. Please charge any fee deficiencies or credit any overpayments to Deposit Account No. 50-2036 with reference to our Docket No. 87289.1741.

Respectfully submitted,
BAKER & HOSTETLER LLP



S. Sahota

Registration No. 47,051

Date: December 26, 2007
Washington Square, Suite 1100
1050 Connecticut Avenue, N.W.
Washington, D.C. 20036-5304
Telephone: 202-861-1500
Facsimile: 202-861-1783